REMARKS

Claims 1, 4, 6-9, 12, 13 and 21 are now presented in the application. Claims 1, 4, 6-9, 12 and 21 are drawn to the elected invention. Claim 13 is directed to a non-elected invention and may be cancelled by the examiner upon the allowance of the claims directed to the elected. Claim 1 has been amended to recite "the cationic resin composition being a sulfonium group- and propargyl group-containing one" from claim 5. Accordingly, claims 3, 5 and 14-20 have been cancelled without prejudice or disclaimer. The amendments to the claims do not introduce any new matter and not present any new issues.

The rejections of claims 14, 15, 17 20 under 35 USC 112, second paragraph have been rendered moot by the cancellation of these claims.

Claims 1, 3-9, 12 and 14-21 were rejected under 35 USC § 103 (a) as being unpatentable over US Patent 4,781,969 to Kobayashi et al. in view of US Patent 4,844,784 to Suzuki et al. and in view of US Patent 6,262,146 to Sakamoto et al. The cited references do not render obvious the above claims as amended.

It would not be obvious to combine US Patent 6,262,146 to Sakamoto et al. with US Patent 4,781,969 to Kobayashi et al. and US Patent 4,844,784 to Suzuki et al. since, among other things, US Patent 6,262,146 fails to disclose that a cationic resin composition can be used as an adhesive or to provide insulation.

An object of the present invention is to provide a method of producing a laminate that is excellent in insulation and adhesive strength between a conductive material and a functional material. On the other hand, US Patent 4,844,784 to Suzuki et al. is to provide a flexible substrate on which an electroconductive adhesive layer is formed on only an electroconductive circuit. Therefore, the present invention differs entirely from the suggestions in US Patent 4,844,784 in terms of the technical fields and problems to be solved by them.

Furthermore, at the time of filing the present application, there was not known any cationic electrodepositable adhesive composition that could be heated and dried in a temperature

range within which no curing reaction occurs, that is substantially incapable of generating any volatile component in the step of heating for curing, and that is capable of forming an insulating layer.

Consequently, a person skilled in the art would not have been motivated by Suzuki et al. to make the present invention. Accordingly, it would have been non-obvious and would have been difficult for a person skilled in the art to apply the method suggested in Suzuki et al. to a method of producing a laminate that is excellent in insulation.

The references do not teach or suggest all of the claim limitations. The prior art references when combined must teach or suggest all of the claim limitations in a proper obviousness rejection. *In re Vaeck*, 947 F.2d 488, (Fed. Cir.1991).

The cited art lacks the necessary direction or incentive to those or ordinary skill in the art to render the rejection under 35 USC 103 sustainable. The cited art fails to provide the degree of predictability of success of achieving the properties attainable by the present invention needed to sustain a rejection under 35 USC 103. See *KSR Int'l Co. v. Teleflex, Inc*, 127 S.Ct. 1727; 82 USPQ2d 1385 (2007), *Diversitech Corp. v. Century Steps, Inc.* 7 USPQ2d 1315 (Fed. Cir. 1988), *In re Mercier*, 185 USPQ 774 (CCPA 1975) and *In re Naylor*, 152 USPQ 106 (CCPA 1966).

Moreover, the properties of the subject matter and improvements which are inherent in the claimed subject matter and disclosed in the specification are to be considered when evaluating the question of obviousness under 35 USC 103. For instance, the cited art fails to suggest obtaining a laminate that is excellent in insulation. See *KSR Int'l Co. v. Teleflex, Inc*, supra; 82 USPQ2d 1385 (2007), *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d. 1923 (Fed. Cir. 1990), *In re Antonie*, 195 USPQ 6 (CCPA 1977), *In re Estes*, 164 USPQ 519 (CCPA 1970), and *In re Papesch*, 137 USPQ 43 (CCPA 1963).

No property can be ignored in determining patentability and comparing the claimed invention to the cited art. Along these lines, see *In re Papesch*, supra, *In re Burt et al*, 148 USPQ

548 (CCPA 1966), *In re Ward*, 141 USPQ 227 (CCPA 1964), and *In re Cescon*, 177 USPQ 264 (CCPA 1973).

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Office is authorized to charge any necessary fees due with this paper to Deposit Account No. 22-0185, under Order No. 27604-00001-US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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